



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,139	03/06/2002	William D. Tandy	4333.IUS (99-0257.1)	9714
24247	7590	01/21/2004	EXAMINER	
TRASK BRITT			CHANG, VICTOR S	
P.O. BOX 2550			ART UNIT	
SALT LAKE CITY, UT 84110			PAPER NUMBER	

1771

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,139

Applicant(s)

TANDY ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/18/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 11/18/2003. Applicants' amendments to the specification and Figs. 4A and 5 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.
4. With respect to applicants' request of a copy of PTO-1449 filed 7/17/2002 (Remarks, page 8), the Examiner notes that there is no record of aforementioned PTO-1449. The Examiner suggests Applicants provide a copy of the missing PTO-1449, along with a copy of the certificate of mailing, so as the Information Disclosure Statement can be entered properly.

Drawings

5. Despite corrections, it is noted that newly corrected Fig. 5 now contains an apparent error of having an element 1B pointing to two distinct parts of the drawing. Also, the element 2B (see paragraph [0049]) is absent from any of the drawings. Corrected drawing is required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Response to Amendment

6. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The compositions and properties of the first and second adhesive layers are critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure, substantially for the reasons set forth in section 7 of Paper No. 0926, together with the following additional observations.

More particularly, in claim 1, the lacking of a suitable composition and properties of the "second adhesive" renders the instantly claimed invention unduly broad and in excess of provided enablement, e.g., the "second adhesive" could encompass the "first outermost adhesive", and forms one single layer.

7. Claims 5, 13 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention, substantially for the reasons set forth in section 6 of Paper No. 0926, together with the following additional observations.

More particularly, the Examiner repeats (see Paper No. 0926, page 3) that the recitation "curing said first outermost adhesive layer results in a loss of adhesion between said first outermost adhesive layer and said second adhesive layer" is not commensurate in scope with the written description, and they appear to be "new matter".

Applicants' argument that paragraph [0018] provides "a clear description of the utility of the claimed invention" (Remarks, page 11, third paragraph) has been carefully considered, but is not persuasive. The Examiner notes that while [0018] discloses "the mixture layer cures and bonds to the die surface", [0018] lacks any express or inherent teaching that "curing said first outermost adhesive layer results in a loss of adhesion between said first outermost adhesive layer and said second adhesive layer".

Applicants' argument that paragraph [0044] provides "a clear description of the utility of the claimed invention" (Remarks, page 11, fourth paragraph) has also been carefully considered, but is not persuasive. The Examiner notes that while [0045] (not [0044]) discloses "the adhesive layer of the carrier tape is UV (or electromagnetic radiation) sensitive such that upon exposure to UV light (or electromagnetic radiation), the adhesive properties of carrier tape 4 are reduced, ...", [0045] lacks any express or inherent teaching that "curing said first outermost adhesive layer results in a loss of adhesion between said first outermost adhesive layer and said second adhesive layer". In particular, [0045] also clearly teaches a curable adhesive layer which structurally corresponds to the "second layer" of claim 1, which is not commensurate with the recitation "curing of said first outermost adhesive layer" in claims 5, 13 and 21.

Additionally, Applicants' argument that paragraphs [0048] and [0049] provide "a clear description of the utility of the claimed invention" (Remarks, pages 11-12, bridging paragraph; and page 12, first paragraph) has been carefully considered, but is not persuasive. The Examiner notes that [0050] (not [0048] or [0049]) discloses that "The second adhesive layer may also be formed to be electromagnetic radiation-curable and

adhere to the first mixture layer and carrier tape 4 in an uncured state. Upon exposure to radiation, the second adhesive layer can either cure onto the first mixture layer or, alternatively, lose its adhesive properties and facilitate peeling of carrier tape 4". As such, again, [0050] clearly teaches a curable adhesive layer which structurally corresponds to the "second layer" of claim 1, which is not commensurate with the recitation "curing of said first outermost adhesive layer" in claims 5, 13 and 21, Applicants' argument to the contrary notwithstanding.

8. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, substantially for the reasons set forth in section 9 of Paper No. 0926, together with the additional observations as set forth above.

In particular, the Examiner repeats (see Paper No. 0926, page 5) that for claims 2-4, 6, 10-12, 14, 18-20 and 22, they are clearly directed to the steps of use, and are lack of any additional structural element. As such they are clearly improper and informal. The Examiner strongly suggests that these claims should be re-written as process of use, if appropriate support in the Specification can be found.

9. Claims 1, 7-9, 15-17 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weng et al. (US 5972234), substantially for the reasons set forth in section 11 of Paper No. 0926, together with the following additional observations.

With respect to Applicants' response arguing that " a fair reading of Weng et al. reference teaches or suggests only the use of an (one) adhesive layer, not the claimed inventions of a first adhesive layer of a mixture of electromagnetic radiation-curable

components" and "Weng et al. does not have any teaching or suggestion whatsoever regarding two different adhesive layers" (Remarks, pages 17-18, bridging paragraph), the Examiner repeats (see Paper No. 0926, pages 5 and 6) that Weng teaches a laser mark tape of polymeric material and a method of marking the tape with an identification mark by a high-intensity energy beam (column 2, lines 20-21), which clearly reads on the instantly claimed element of a first adhesive layer of a mixture of electromagnetic radiation-curable components, and Weng expressly teaches that one of suitable material is polymeric based material which can be easily patterned by high intensity energy beam such as UV light or laser (column 4, lines 28-33). As to the adhesiveness of the mark tape, Weng expressly teaches that the polymeric based tape can be provided either with an adhesive backing or without an adhesive backing, and the tape may be laminated to the surface of the electronic substrate by any means without using the adhesive layer (column 5, lines 39-43), as such it is believed that Weng's mark tape clearly encompasses at least hot-melt polymeric material for laminating capability, which constitutes a multilayered adhesive structure when the adhesive layer is present, as taught in one of the embodiments by Weng, Applicants' argument to the contrary notwithstanding.

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0994.

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 4389-
1700

Daniel Zinker